## REMARKS

This amendment and response under 37 C.F.R. §1.143 is in response to an election/restriction requirement (Paper No. 012006) mailed January 27, 2006. Claims 1 through 31 are pending. No claims are amended.

In Paper No. 012006 mailed on 27 January 2006, the Examiner imposed a restriction between:

- Group I covered by claims 1-16, drawn to a method for processing and separating imbricate formation of flexible flat objects, classified in class 271 and subclass 3.01;
- Group II covered by claims 17-25, drawn to a guide, classified in class 271 and subclass 264;
- Group III covered by claims 26-31, drawn to a guiding method, classified in class 271 and subclass 264.

Applicant provisionally elects, with traverse, Group I drawn to a method for processing and separating imbricate formation of flexible flat objects, classified in class 271 and subclass 3.01, with traverse. Claims 1 through 16 are within the elected Group I.

Applicants object to the imposition of this requirement for restriction requirement on the following grounds.

**First**, the subject matter of the three groups overlap. In addition, the mandatory fields of search for the three embodiments are substantially coextensive. Moreover, the Examiner has stated

that the invention of claims 1 through 16 are classified in Class 271, Subclass 3.01,[1] and that the invention of Group II, claims 17 through 25 and that the invention of Group III, claims 26 through 31 are also both classified in Class 271, although at Subclass 264,[2] it is submitted that, in order to perform a comprehensive search, the mandatory field of search for elected Group I must include Class 271, subclass 264 because subclass 264 is a breakout of subclass 8.1;[3] the field of mandatory search of Group I includes subclass 3.14[4] as well as subclass 8.1, and their various breakouts.[5] The attention of the Examining staff is invited to note that although the main classifier of subclass 3.01 is a *stack*, a feature which is not recited *per se* by Applicant's claim 1; all of Groups I, II and III do however, recite common features (*e.g.*, *guiding*) which are common to the 3.14 and 8.1 subclasses. Thus, the mandatory fields of search necessarily overlap and are substantially coextensive for all three of the groups of claims, and therefore the restriction requirement serves no purpose other than to impose an undue burden and unnecessary expense upon the Applicants (*see* MPEP §802.01, §806.04, §808.01). There would be no serious burden on the Examiner and as required by *MPEP* §803, the Examiner must examine the entire application on the merits.

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1 Delivering To Stack And Feeding Therefrom

2 Feeding ... By means to convey sheet (e.g., from pack to operation).

3 Feeding ... By means to convey sheet (e.g., from pack to operation).

4 Feeding And Delivering.

5 The Examiner's classification of Group I is suspect because claim 1 does not define either a *stack* or *delivering to a stack* or *feeding from a stack*. Applicant submits therefore, that the mandatory field of search from all three group both main subclasses 3.14 (*Feeding And Delivering*) and 8.1 (*Feeding*), as well as several of their respective breakout subclasses.

**Second,** rising to level of a *serious* burden is seriously suspect, especially in light of the generic claims involved. It appears that the restriction requirement is being imposed here merely for administrative convenience, and such a basis for imposition of a restriction requirement has been prohibited in previous decisions of the Commissioner.

As specifically stated in *Manual of Patent Examining Procedure,* 8th Edition, Revision 3 (August 2005), §803, in imposing a restriction requirement, the Examiner must show that: (A) the inventions are independent (*see also* MPEP §802.01, §806.04, §808.01) or distinct as claimed (*see further* MPEP §806.05 - §806.05(i)); **and** (B) there will be a **serious burden** on the Examiner if the restriction requirement is not imposed (*see* MPEP §803.02, §806.04(a) -§806.04(i),§808.01(a), and §808.02). It is respectfully submitted that in an examination of the above-captioned application, there would **not be a serious burden** upon the Examiner in searching the invention of Groups I, II and III because the Examining staff has failed to show any type of burden, much less a serious burden, in the absence of a restriction requirement. In particular, not only has the Examiner failed to show that the search would impose a burden, but also the Examiner has failed to show that any burden would rise to the level of a serious burden. As stipulated in MPEP §803, if the search can be made without serious burden, the Examiner **must examine the application on the merits,** even if there are separate and distinct inventions. The Examiner has not alleged any serious burden in the Office action mailed on 12 January 2006 (Paper No. 20060106) and thus the Examiner must examine the entire application. Moreover, because no burden was shown, if the restriction is not withdrawn in the next Office action, the restriction requirement can not be made final according to MPEP §706.07. Therefore, there would be no serious burden on the Examiner and as required by *MPEP* §803, the Examiner must examine the entire application on the merits.

**Third**, *MPEP* §806.03 states that:

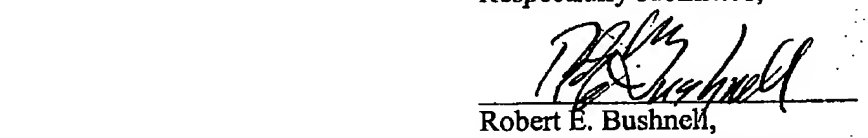
> "Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween **should never be required**. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition" (emphasis supplied).

Why, then has this prohibition been violated in the above-captioned application where a single embodiment has been disclosed? That fact that Applicant's claims are very broad in scope, and cover a plethora of implementations of the principles of Applicant's inventions, is not a basis for violating this prohibition against restriction. Withdrawal of this requirement is therefore respectfully urged.

In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Amendment.

Respectfully submitted,



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